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REMARKS

The above amendments and these remarks are submitted in reply to the Office Action dated February 2, 2004.

Summary of the Examiner's Objections/Rejections

The specification has been objected to for not citing the serial number of the co-pending application mentioned on page 11, line 15. Claims 37, 45 and 51-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rawson (U.S. Patent No. 5,265,252) in view of Davis (U.S. Patent No. 5,844,986).

Objection to Specification

The specification has been amended to include the serial number of the co-pending application mentioned on page 11, line 15. Accordingly, reconsideration of the objection to the specification is respectfully requested.

Allowable Subject Matter

The Applicants wish to thank the Examiner for indicating that the subject matter presented in Claims 39, 41-42, 46 and 49-50 would be allowable if rewritten in independent form.

Rejection of Claims 37-44

The Applicants traverse the rejection of the aforementioned claims for the reasons set forth in greater detail below. First, the Applicants submit that the Examiner has not established a proper prima facie case of obviousness, as there is no motivation present in Rawson, III, et al. to combine the teachings thereof with those of Davis as submitted by the Examiner. In order to establish a proper prima facie case of obviousness, there must be some suggestion or motivation...in the references themselves to combine reference teachings. MPEP 2142-2143. In the instant case, such suggestion or motivation is missing from the Rawson, III, et al reference. As clearly stated by the Examiner, for example, on page 3, paragraph 2 of the instant office action:

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"...Rawson makes no mention of providing security for issued commands through the use of signatures and cryptographic key pairs..."

Thus, the Examiner has admitted that one of the references of the combination relied on to establish the rejection, does not suggest or provide the proper motivation to be combined with the secondary reference. Additionally, Davis does not teach or suggest a "...service request including a service request signature created using a private key in a cryptographic key pair..." Consequently, the Applicants submit that a prima facie case of obviousness has not been established and that the rejection under 35 U.S.C. §103 should be withdrawn.

Second, notwithstanding the improper combination of Rawson, III, et al. and Davis, the combined teachings of such references still do not render the claimed invention obvious. More specifically, Claim 37 is directed to a system including the following limitations:

"...an access driver to generate a service request to utilize BIOS services, the service request including a service request signature created using a private key in a cryptographic key pair..." and

"...an interface module to verify the service request signature using a public key in the cryptographic key pair to ensure the integrity of the service request..."

which are not taught or suggested by the combination of references as cited by the Examiner. Consequently, the combination of Rawson, III, et al. and Davis does not render the claimed invention obvious. As recited in Claim 37, the service request includes a service request signature created using a private key. This particular element is not taught or suggested by the combination of Rawson, III, et al. and Davis.

As admitted by the Examiner, for example, on page 3, paragraph 2 of the instant office action "...Rawson makes no mention of providing security for issued commands through the use of signatures and cryptographic key pairs..." Thus, Rawson, III et al. does not render the claimed invention obvious. To compensate for the aforementioned shortcoming of Rawson, III et al. the Examiner combines the teachings of Davis to the teachings of Rawson, III et al. However, Davis also does not teach or suggest the

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aforementioned claim language. Accordingly, the combination of Rawson, III et al. and Davis does not render the claimed invention obvious.

As understood, Davis is directed to a method for authenticating and validating a code (e.g. BIOS) update. See, for example, col. 2, lines 38-40. As disclosed, for example, at col. 3, lines 61-63; col. 4, lines 20-23 and col. 4, lines 55-56, the validation is performed by authenticating or verifying "...any digital signature embedded in the upgrade code..." (See, for example, col. 4, lines 30, 33 and col. 4, lines 55-56). Thus, the verification procedure disclosed in Davis authenticates the contents of what is to be operated on, not the request for servicing or operating on subsequent contents. The actual request to perform such an operation does not include a service request signature (see, for example, col. 3 lines 48-50). In fact, including a service request signature with the actual request to perform an operation is not taught or suggested in Davis. Thus, Davis does not teach or suggest a request, for example, to upgrade the BIOS code including a "...service request signature created using a private key in a cryptographic key pair..." as recited in Claim 37. Consequently, the combination of Rawson, III et al. and Davis does not teach or suggest the invention as defined in Claim 37. Accordingly, reconsideration of the rejection of Claim 37 is respectfully requested.

Claims 38-44 directly or indirectly depend upon and include the limitations of Claim 37 and are allowable at least for the reasons set forth above with respect to Claim 37. Moreover, these claims define subject matter that is independently allowable over the art of record. The Examiner even admits the same by stating, for example, on page 6, paragraph 9 that Claims 39 and 41-42 contain novel subject matter. Accordingly, reconsideration of the rejection of Claims 37-44 is respectfully requested.

Rejection of Claims 45-50

The Applicants traverse the rejection of the aforementioned claims for the reasons set forth in greater detail below. The lack of a prima facie case of obviousness as discussed above with respect to the rejection of Claim 37 is equally applicable to the rejection of Claim 45 and is incorporated in its entirety herein. Claim 45 is directed to a method to securely invoke Basic Input and Output System services. Claim 45 includes limitations directed to:

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"...signing the service request with a service request signature generated using a private key in a cryptographic key pair..." and

"...verifying the service request signature using a public key in the cryptographic key pair to ensure the integrity of the service request..."

which are not taught or suggested by the combination of Rawson, III et al. and Davis. As discussed in greater detail above with respect to Claim 37, neither reference teaches or suggests signing a service request with a service request, or digital, signature or verifying the same. As such, Claim 45 is submitted to be allowable at least for the reasons set forth above with respect to Claim 37. Accordingly, reconsideration of the rejection of Claim 45 is respectfully requested.

Claims 46-50 directly or indirectly depend upon and include all of the limitations of Claim 45 and are submitted to be allowable at least for the reasons set forth above with respect to Claim 45. Moreover, these claims define novel subject matter that is independently allowable over the art of record. The Examiner even admits the same by stating, for example, on page 6, paragraph 9 that Claims 46 and 40-50 contain novel subject matter. Accordingly, reconsideration of the rejection of Claims 45-50 is respectfully requested.

Rejection of Claim 51

The Applicants traverse the rejection of the aforementioned claim for the reasons set forth in greater detail below. The lack of a prima facie case of obviousness as discussed above with respect to the rejection of Claim 37 is equally applicable to the rejection of Claim 45 and is incorporated in its entirety herein. Claim 51, like Claim 37 includes the following limitations:

"...an access driver to generate a service request to utilize BIOS services, the service request including a service request signature created using a private key in a cryptographic key pair..." and

"...an interface to verify the service request signature using a public key in the cryptographic key pair to ensure the integrity of the service request..."

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As such, Claim 37 is submitted to be allowable at least for the reasons set forth above with respect to Claim 37. Accordingly, reconsideration of the rejection of Claim 37 is respectfully requested.

Rejection of Claim 52

By this Amendment, Claim 52 has been cancelled. Accordingly, the Applicants submit that the rejection of the aforementioned has been rendered moot.


CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that Claims 37-51 are now in proper condition for allowance and such action is earnestly solicited.

The Commissioner is hereby authorized to charge any underpayments or credit any over payments to Deposit Account No. 16-1520 for any payment in connection with this communication, including any fees for extension of time, which may be required. The Examiner is invited to call the undersigned if such action might expedite the prosecution of this application.

Respectfully submitted,
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